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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------|
| 09/909,284 | 07/19/2001 | Joseph M. Dewig | 5723-68359 | 2204 |
| 23643 | 7590 | 12/24/2003 | EXAMINER | |
| BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204 | | | | HAMDAN, WASSEEM H |
| | | ART UNIT | | PAPER NUMBER |
| | | 2854 | | |

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/909,284 | DEWIG ET AL. |
| | Examiner Wasseem H Hamdan | Art Unit 2854 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. This office action is in response to applicant's amendment filed on 11/20/2003.
2. The rejection of claims 1, 2, 5-9, 14, 18, 19, 24, 25, 28, 29 and 30 under 35 U.S.C. 103(a) as being unpatentable over Woodside, III (US Patent 5,425,823) in view of Horth et al. (US Patent 5,970,865) has been withdrawn, and a new rejection has been set forth as necessitated by the personal interview.
3. The rejection of claims 3, 4, 10-13, 15-17, 20-23, 26, 27 and 31-33 under 35 U.S.C. 103(a) as being unpatentable Woodside, III (US Patent 5,425,823) in view of Horth et al. (US Patent 5,970,865) as applied to claims 1, 2, 5-9, 14, 18, 19, 24, 25, 28, 29 and 30 above, and further in view of MaCoy et al. (US Patent 6,257,136 B1 has been withdrawn, and a new rejection has been set forth as necessitated by the personal interview.

Drawings

4. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 14, are indefinite because they recite “such as” in line 1. “such as” is not acceptable claim language.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5-9, 14, 18, 19, 24, 25, 28, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Vander Griendl et al. (US Patent 4,337,719).

Regarding claims 1, 14, 18, 19, 24, 25, 29 and 30 Vander Griendl et al. discloses an apparatus for applying a label to an object “such as” a container or cup [FIGS. 1; column 1, lines 7-11], the apparatus comprising:

a printer [FIG. 1; column 2, lines 12-18],

a label applicator coupled to the printer [FIG. 1 (12); column 2, lines 12-18 (wherein the varnishing station is the same as label applicator, also admitted by applicant in the specification on page 4, line 20],

a holder configured to engage the object and move the object relative to the printer and the label applicator [FIGS. 1 (15) also admitted by applicant in the specification on page 4, line 22], the label applicator configured to apply a label when the object is disposed near the label applicator [FIGS. 1], and the printer configured to print an image on a surface of the object when the object is disposed near the printer [FIG. 1; column 2, lines 12-17 (applicant admission in the specification page 4, lines 20, 21], and

a control system [applicant specification page 4, lines 29-32] coupling the printer and the label applicator to coordinate the printing of the object [FIGS. 1; column 2, lines 12-17 (wherein the decoration apparatus is the same as the printing)].

Regarding claims 2 and 28 Vander Griendt et al. discloses wherein the label applicator is positioned relative to the printer such that the label is applied to the object at substantially the same time that the image is printed on the surface of the object [FIG. 1: column 2, lines 12-18].

Regarding claims 5 and 6, Vander Griendt et al. discloses the label applicator includes means for removing the label from a backing prior to application of the label to the object [FIG. 1; column 1, lines 61-68; column 2, lines 1-12].

Regarding claims 7 and 8, Vander Griendl et al. discloses wherein the retaining means retains the label with vacuum pressure [column 3, lines 21-22].

Regarding claim 9, Vander Griendl et al. discloses wherein the retaining means includes a valve means for supplying sufficient air flow to position and move the label [column 3, lines 4-22].

9. Claims 3, 4, 10-13, 15-17, 20-23, 26, 27 and 31-33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vander Griendl et al. (US Patent 4,337,719) in view of McCoy et al. (US Patent 6,257,136 B1).

Regarding claims 3, 4, 10, 11, 15, 16, 20, 26, 27 and 31-33 Vander Griendl et al. discloses the essential elements of the claimed invention except for the control system includes a programmable limit switch coupled to the printer. McCoy et al. discloses that the control system includes a programmable limit switch coupled to the printer [FIG. 21 (232); column 13, lines 40-67; column 14, lines 1-3]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Vander Griendl et al. by including a programmable limit switch coupled to the printer, since McCoy et al. teaches a programmable limit switch coupled to the printer would be beneficial to provide a plurality of discrete electrical output control signals each designed to provide electrical control of diverse machine elements at preselected intervals during each machine cycle of a decorator.

Regarding claims 12, 13, 17, 20-23, 26 and 27 it is a functional means for the claimed apparatus, which the system is capable to do the same function, by using the programmable limit switch which it is taught as discussed above McCoy et al.

Regarding claims 20-23, 26 and 27, according to "IEEE Standard Dictionary of Electrical and Electronics Terms" page 355 (right column), "encoder: a system in which only one input is excited at a time and each input produces a combination of outputs", and according to Rockwell article about "Programmable Limit Switch (PLS)" (is incorporated herein by reference), page 2, that one of the PLS functions is to" control outputs for press automation synchronized with the rotational position of the press crankshaft as monitored by a resolver input (function of PLS), therefore, the PLS taught by McCoy et al. can and will do the same function as the encoder claimed in claim 20. Please note that this also was addressed in the first office action mailed on 07/21/2003.

Regarding claims 32 and 33 it is a functional means for the claimed apparatus, which the system of McCoy et al. is capable to do the same function, by using the programmable limit switch, which it is taught as discussed above McCoy et al. Please note that this also was addressed in the first office action mailed on 07/21/2003.

Regarding claims 32 and 33, according to Rockwell article about "Programmable Limit Switch (PLS)" (is incorporated herein by reference), page 2, that one of the PLS functions is to" control outputs for press automation synchronized with the rotational position of the press

crankshaft as monitored by a resolver input (function of PLS), therefore, the PLS taught by McCoy et al. can and will do the same function as the cycle status and communication relative position claimed in claims 32 and 33. Please note that this also was addressed in the first office action mailed on 07/21/2003.

Response to Arguments

10. Applicant's remarks filed on 11/20/2003, Applicant stated in the remarks that "the Examiner agreed that Claims 1 and 14 were allowable". The examiner respectfully disagrees. As stated in the Interview Summary that was conducted on 11/19/03, and a copy was given to the applicant after the interview was over that "It was agreed that the two references 5,425,823 and 5,970,865 are not combinable for claims 1 and 14 only. Further search and time needed for the rest of the claims 18, 24 and 29". The examiner never ever mentioned the word allowable. It is also important for the applicant to know that our policy is never to say the word allowable or to allow any claims in a Personal Interview. A new rejection is set forth as stated above. Also, applicant's remarks are moot based on the new ground of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0956.

Wasseem Hamdan

Wasseem H. Hamdan

December 22, 2003

Charles M. Nielsen
Charles M. Nielsen, Jr.
Primary Examiner
Tech Center 2800